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<u>11/30/2007</u>	<u>/Pamela Gerik/</u>
Date	Pamela Gerik

SUPPLEMENTAL APPEAL BRIEF

Dear Sir:

This supplemental appeal brief is submitted in response to the Notice of Non-Compliant Appeal Brief mailed November 21, 2007. Appellant hereby appeals to the Board of Patent Appeals and Interferences the rejections of claims 21-36, 38, 39, and 41.

I. REAL PARTY IN INTEREST

The parties in real interest are the inventors, Charles D. Huston and Darryl J. Cornish.

II. RELATED APPEALS AND INTERFERENCES

Prior appeals may have a bearing on the Board's decision in this appeal. The present application is a continuation of Serial Number which 08/925,293 which was decided by this Board in Appeal No. 2000-0947. Appeal No. 2000-0947 was appealed to the Court of Appeals for the Federal Circuit 02-1048 decided October 17, 2002. Additionally, Serial Number 09/454,813 was decided by the Board January 24, 2006 in Appeal No. 2005-2769.

III. STATUS OF THE CLAIMS

Claims 21-36, 38, 39 and 41 are pending and stand rejected. Claims 1-20, 37 and 40 are canceled. Claims 21-36, 38, 39 and 41 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

No amendments to the claims were filed subsequent to their final rejection. Therefore, the Appendix hereto reflects the current state of the claims. (Applicants reserve the right to continue prosecution after the Board's decision and specifically notes several typographical errors.)

V. SUMMARY OF CLAIMED SUBJECT MATTER

Broadly, the present subject matter relates to a system and method for displaying advertising messages and other information to a golfer on a golf course in a non-intrusive, non-distracting, tasteful manner and time. The advertising messages are displayed based on the position of a golfer on a golf course using a Global Positioning Satellite system ("GPS") and comparing this GPS position with a database of message locations. The parent application, SN 07/804,368 now U.S. Pat. No. 5,364,093, described an invention for determining distances on a golf course using the Global Positioning Satellite system (GPS), e.g. the distance from the ball to the cup. The present application refines how specific advertising information is communicated to the golfer based on the golfer's GPS position.

Three independent claims are presented on appeal, claims 21, 32, and 41. The references herein are exemplary only and often refer to the preferred embodiment, and are not intended to limit the scope of the claims.

Claim 21. Independent claim 21 recites a method for displaying an advertising message, (Figs. 5-6, display 121) to a golfer on a golf course using a global positioning satellite system (Figs. 5, 6, and 11; Specification -- p. 5, line 1 - p. 6, line 2; p. 12, lines 12-40). As described, a

GPS receiver, (Figs. 2, 4 remote unit 10), is positioned on the golf course and a present position is determined. An advertising location is stored and compared to the present position of the GPS receiver, (Fig. 2, remote unit 10; Specification -- p. 12, line 35 - p. 13, line 4; p. 13, lines 11-17). If the present position is an advertising location, the advertising message is displayed to the golfer (Figs. 5-6).

Claim 32. Independent claim 32 recites an apparatus (Figs. 2, 4 remote unit 10) which displays a message (such as display 121, Fig. 5; Fig. 6), to a golfer using a GPS system (Figs. 2, 4, and 5; Specification -- p. 5, line 1 - p. 6, line 2; p. 12, lines 12-40). The GPS receiver (Figs. 2, 4 remote unit 10) receives signals indicating an apparent position of receiver 10 on a golf course (Fig. 2; Specification -- p. 10, line 5 - p. 11, line 3). A processor (Fig. 2, CPU 24) determines the position of receiver 10 (Fig. 2; Specification -- p. 10, line 33 - p. 11, line 4). A memory, e.g., storage 25 stores a set of message locations (Fig. 2; Specification -- p. 10, line 33 - p. 11, line 4; p. 12, line 12 - p. 13, line 28). The processor 24 compares the position of receiver 10 with a message location (Fig. 2; Specification -- p. 12, line 12 - p. 13, line 28). A display 121 displays the message to the golfer (Fig. 5).

Claim 41. Independent claim 41 recites a method for displaying advertising information to a golfer on a golf course using a GPS system (Figs. 5-6; Specification -- p. 5, line 1 - p. 6, line 2; p. 12, line 12 - p. 13, line 28). As described, a GPS receiver (Fig. 2, receiver 10) is positioned on a golf course and a present position of receiver 10 is determined (Fig. 2; Specification -- p. 10, line 33 - p. 11, line 3). Advertising information associated with one or more locations are stored in a memory, e.g., storage 25 (Specification -- p. 12, line 35 - p. 13, line 4; Fig. 2). The advertising information locations are compared with the position of receiver 10 (Fig. 2). If the position of the receiver is at an information location, the information is displayed (Fig. 5; Specification -- p. 12, line 12 - p. 13, line 28).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 21-33, 35, 36, 38, 39 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,524,081 to Paul (hereinafter “Paul”) in view of U.S. Patent No. 5,326,095 to Dudley (hereinafter “Dudley”).
2. Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul, Dudley, and WO 88/00487 to Bonito et al. (hereinafter “Bonito”).
3. Claims 21-36, 38, 39 and 41 were rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-26 of U.S. Pat. No. 5,364,093 in view of Paul or Dudley.

VII. ARGUMENT

The contentions of the Appellant with respect to the ground of rejection presented for review, and the basis thereof, with citations of the statutes, regulations, authorities, and parts of the record relied upon are presented herein for consideration by the Board. Details as to why the rejections cannot be sustained are set forth below.

1. Rejection of claims 21-33, 35, 36, 38, 39, and 41

Paul teaches that information can be sent by radio to golfers and that the types of information that can be broadcast include advertising, leader board updates, weather alerts etc. (Col. 8 lines 18-20). Dudley teaches that information can be conveyed to a golfer when the golfer is in proximity to a buried tag on the golf course. Such information can include range information, such as distance to the green or a hazard (col. 4, lines 10-13) or advertising information (col. 7, lines 13-16). Appellant does not believe that one of ordinary skill would combine the teachings of Paul and Dudley because, *inter alia*, such combination would change the operating principle of both references. Certainly, no reason for the combination is explicit in the record. Even if the combination is appropriate, the combination does not meet the claim limitations.

The subject matter of this application has a tortured history and, not surprisingly, unusual facts. The claims now presented on appeal are different than prior appeals 2005-2769 and 2000-0947 and the primary references are different. Therefore, this appeal merits independent consideration. However, because prior appeal 2000-0947 and the attendant Federal Circuit decision 02-1048 may be relevant, they are included herewith in the Related Proceedings Appendix.

A. The obviousness rejection based on the hypothetical combination of Paul and Dudley

The prior art rejections in the final Office Action were under 35 U.S.C. § 103(a) as being unpatentable over a combination of Paul in view of U.S. Patent No. 5,326,095 to Dudley (hereinafter “Dudley”). The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), establish the background for determining obviousness under 35 U.S.C. §103, see also, MPEP 706 and 2141. The primary considerations are: the scope and content of the prior art; the differences between the prior art and the claims in issue; the level of ordinary skill in the pertinent art; and secondary considerations, such as commercial success, long felt and unresolved needs, failures of others, teaching away, etc. See also, *KSR Int’l. Co., v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). While the *KSR* court rejected the rigid application of the “teaching, suggestion, motivation” test, the reason a person of ordinary skill in the relevant field would combine prior elements must be made explicit. *KSR*, slip op. at 14.

i. Scope and Content of the Prior Art

Turning to the scope and content of the prior art, Paul describes that information, including advertising, can be radio broadcast to golfers on a golf course. Paul mentions the ability to “broadcast” advertising, leader board updates, weather alerts etc. (Col. 8 lines 18-20). Nothing else in Paul relates to advertising. Paul does not teach the claim limitations nor suggest a need for performing location based advertising. The Board’s reading of Paul is essentially correct in the prior appeal (2000-0947). The Board states that “in addition to broadcasting the differential corrections in that it provides a mechanism for broadcasting messages to all carts or any specific cart. The broadcasts can include notices from the clubhouse, weather alerts,

advertising, leader board updates, etc.” No reference can be found in Paul (by the Board or Applicant) that suggests advertising to a golfer based on a GPS-determined position on a golf course, where the golfer’s position is a stored advertising location.

Dudley is directed to a system for providing yardage and position information at various points on a golf course hole based on proximity to a buried tag. In one embodiment, radio frequency (RF) identification tags are buried beneath the cart path on the golf hole at regularly spaced intervals (col. 4, lines 1-5). Alternatively, the tags may be buried in a two-dimensional matrix so that readings are available at many more points and so that the cart does not have to remain on the cart path to receive information from the tag (col. 4, lines 18-26). As a reading system passes over a tag, the reading system sends an interrogation signal that causes the tag to output its internally stored code (col. 4, lines 5-9). This code may be utilized by the reading system to determine range information, such as distance to the green or a hazard (col. 4, lines 10-13). In addition, the information to be output for each received tag code may be determined by a look-up table stored in the RAM of the reading system and correlated detailed sets of stored information (col. 6, lines 46-50; col. 6, line 62 to col. 7, line 2). This look-up table may include advertising messages that are activated by particular tags (col. 7, lines 13-16).

Dudley does describe a golf information system for conveying information to a golfer. Dudley uses RF tags buried in the ground, such that when a golfer approaches a tag, certain information such as distance to the green can be conveyed. Dudley does say that advertising information can be conveyed when in proximity to a certain tag (p. 12).

Of course, if the proposed modification or combination would change the principle of operation, then the references are not sufficient to render the claims *prima facie* obvious. *See, In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349 (CCPA 1959). The operating principle of Paul is to broadcast messages to all users by radio, including advertising messages, regardless of position. Dudley operates to display information to a golfer based on proximity to a buried tag – *i.e.*, Dudley does not determine a position. Therefore, the operating principles are different and the rejection was in error.

ii. Differences between the prior art and the claims

Even if Paul and Dudley are combined, the claim limitations are not taught or suggested by the proposed combination of Paul in view of Dudley. Again, Paul teaches only that messages, including advertising, can be broadcast over a radio to golfers. Dudley shows that messages, including advertising messages, can be triggered when in proximity to a buried tag. As such, Paul does not even suggest a problem of displaying advertising messages to users based on the users location, so there would be no motivation to combine the buried tags of Dudley.

Because none of the cited references suggest the location determination techniques of the present invention, it is not surprising that the references do not suggest the limitations in the present claims. Claims 21 and 32 are the broadest independent claims and are directed to advertising on a golf course based on the GPS determined position of the golfer. For example, claim 21 calls for “displaying the advertising message” if “the present position of the remote receiver is an advertising location” where the position is determined with GPS. Dudley suggests displaying advertising to a golfer based on proximity to a buried tag. The proposed combination of Paul and Dudley, even if proper, does not meet the claim limitations of Claims 21 and 32, *e.g.* displaying the advertising message based on “the position of the remoter receiver relative to the message locations” where the position is determined with GPS.

Even if combined, Paul and Dudley are missing elements of claims 21, 32, and 41. None of the references disclose at least “a memory storing a set of message locations on a golf course,” (Claim 32) or “determining the position of a remote receiver on a golf course using the global positioning satellite system,” (Claim 41) or using a GPS position to provide advertising information to a golfer. Claim 21 calls for “selecting one or more advertising locations” and “comparing the one or more advertising locations with the present position of the remote receiver” and displaying an advertising message on the golf course. The hypothetical combination does not describe a memory (Claim 32) for “storing a set of message locations on the golf course” and “displaying the message to the golfer” if the GPS receiver coincides with one of the message locations. Dudley does not disclose at least using a GPS system to locate the position of a remote GPS receiver on a golf course or displaying advertising messages by

comparing the relative position of the remote GPS receiver with respect to the position of stored message locations (e.g. Claim 41). In essence, what the Examiner has done is to piece together aspects from each of these references to assert that claims 21-39 and 41 are obvious. Simply put, the proposed combination does not meet the claim limitations of the independent claims, 21, 32, and 41.

A supposition in the final Office Action might be that given the combination, an artisan skilled in GPS theory and database and memories that managed golf courses could “figure out” the missing elements. The legal test is, however, whether the combination meets the claim limitations, which clearly it does not. *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). As noted above, claim 21 provides that the advertising message is displayed when the position of the receiver means coincides with one of the advertising locations. This limitation is not disclosed or suggested in any of the references of the proposed combination. *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530, 218 U.S.P.Q. 871 (Fed. Cir. 1983) (the issue is not whether the differences would have been obvious, but whether the claimed invention as a whole would have been obvious).

iii. The reason a person of ordinary skill in the relevant field would not combine the prior elements

Of course, if the proposed modification or combination would change the principle of operation, then the references are not sufficient to render the claims prima facie obvious. *See, KSR*, slip op. at 14; *See also, In re Ratti*, 270 F.2d 810, 813, 123 U.S.P.Q. 349 (CCPA 1959). Dudley operated to display information to a golfer based on proximity to a buried tag – *i.e.*, Dudley does not determine a position. Apparently, “Dudley is cited for its teaching of the desirability of transmitting advertisements to golfers at selected positions and not specifically to its position determination methods.” What the final Office Action failed to recognize is that use of proximity (Dudley) would change the operating principle of the claimed invention. Because the operating principle is part of the claims, the proposed combination does not meet the claim limitations. The rejection was thus in error.

The motivation to combine prior art references most often comes from the references themselves and must be clear. In particular, broad conclusory statements are not evidence of a motivation to combine. *Brown & Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 229 F.3d 1120, 1125, 56 U.S.P.Q.2d 1456 (Fed. Cir. 2000). Regardless of the source, there must be some evidence of a motivation to combine. *In re Dembiczak*, 175 F.3 at 999 (“The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.”) The reason for a proposed combination should be explicit. *KSR*, slip op. at 14.

For at least the foregoing reasons, the claims currently presented are allowable over the § 103 issues raised in the final Office Action, and applicant respectfully requests reconsideration and allowance in view of the traversal herein.

2. Rejection of claim 34

Dependent claim 34 is believed patentably distinct over the cited references for at least the same reasons as base claim 33 discussed above.

3. Rejection of Pending Claims on the Ground of Double Patenting

Double Patenting of the obviousness-type is “a judge-made criterion adopted out of necessity where the courts were faced with a situation in which claims in two applications or patents were not drawn precisely to the same invention . . .” *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F. 2d 683 (Fed. Cir. 1990). It does not appear that any case has answered whether this judge-made doctrine has survived Congressional intervention when it amended 35 U.S.C. § 154(a) to a term of 20 years from the date of filing. *See*, Pub. L. 103-465.

When considering a double patenting rejection of the obviousness type, a comparison of the competing claims are made. That is, the earlier patent’s disclosure is not available to show nonstatutory double patenting. *See, Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1281-82 (Fed. Cir. 1992). *See also*, MPEP 804B. 1 (“the disclosure of the patent may not be used as prior art”).

Turning to the present application, the claims of U.S. Pat. No. 5,364,093 must be compared with the claims under examination. Probative, is the Office Action Mailed October 25, 2006, note in para. 2 that the claims under examination are not entitled to the benefit of the filing date of the '093 patent because the '093 patent did not disclose the claimed subject matter. This determination evidences that the present claims would not be considered by one of ordinary skill in the art as disclosed in the manner provided under 35 U.S.C. § 112, first paragraph. While applicant understands that the tests for obviousness and enablement are not identical, this ruling appears relevant to the question of obviousness in view of the '093 claims.

Comparing the present claims under examination, applicant cannot find a single claim in the '093 patent that would render the present claims obvious therefrom, either alone or in combination with Paul or Dudley. Claim 1 of '093 relates to a method for determining the approximate distance on a golf course, while claim 15 relates to an apparatus for determining the approximate distance. Claim 19 relates to tracking locations. None of the claims of '093 would fairly suggest the subject matter of the claims of the present application. For example, the present claims relate to methods and systems for “displaying an advertising message to a golfer on a golf course” at advertising locations. As noted *infra*, Paul relates to radio broadcasts of messages including advertising messages. Dudley relates to messages based on proximity to buried tags. Therefore, there is no motivation or suggestion to combine Paul or Dudley with the claims of the '093 patent, and even if such a combination were made, the present claim limitations are not met.

For at least the reasons stated above, Applicant asserts that the present claims are not taught or suggested by the claims of U.S. Patent No. 5,364,093 alone or in combination with Dudley or Paul. Accordingly, Applicant respectfully requests removal of this rejection.

* * *

For the foregoing reasons, it is submitted that the Examiner's rejection of and objection to pending claims 21-36, 38, 39, and 41 was erroneous, and reversal of the Examiner's decision is respectfully requested.

The Commissioner is authorized to charge the required fees or credit any overpayment to Daffer McDaniel, LLP deposit account no. 50-3268.

Respectfully Submitted,

/Charles D. Huston/

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Date: November 30, 2007

VIII. CLAIMS APPENDIX

21. A method for displaying an advertising message to a golfer on a golf course using a global positioning satellite system comprising the steps of:

positioning a remote global positioning satellite receiver on the golf course;

determining a present position of the remote receiver on the golf course using a global positioning satellite system;

storing one or more advertising locations on the golf course;

comparing the one or more advertising locations with the present position of the remote receiver; and

displaying the advertising message to the golfer if the present position of the remote receiver is an advertising location.

22. The method of claim 21, including a step of determining if the remote receiver is moving using said position and displaying said message when the remote receiver is moving.

23. The method of claim 21, including a step of determining if the remote receiver is moving using said position and displaying said message when the remote receiver is not moving.

24. The method of claim 22, the step of determining if the remote receiver is moving including the substeps of determining another position of the remote receiver and comparing said position and said other position to determine if the remote receiver is moving.

25. The method of claim 21, said message comprising a graphic depiction.

26. The method of claim 21, the displaying step including displaying a golf hole layout on said golf course at other locations on the golf course.
27. The method of claim 21, the displaying step including displaying golf information in addition to said advertising message at other locations on the golf course.
28. The method of claim 27, said golf information comprising a scorecard.
29. The method of claim 27, said golf information comprising a refreshment order page.
30. The method of claim 21, including a step of determining an approximate distance of a golf ball to a feature on the golf course including the substeps of storing the location of the feature in a database, positioning the remote receiver proximate to a golf ball, and determining the distance between said stored feature location and said remote receiver position.
31. The method of claim 21, including a step of determining an error correction for the global positioning satellite system comprising the substeps of:

positioning a global positioning satellite receiver at a reference location having a known position;

determining an apparent position of the reference location using the receiver; and

calculating an error correction based on said apparent position and said known position of the reference location.

32. An apparatus for displaying advertising information to a golfer on a golf course using a global positioning satellite system comprising:

a global positioning receiver for receiving signals indicative of an apparent position of the receiver means using a global positioning satellite system and positionable on the golf course;

a processor linked to said global positioning receiver for determining the position of the receiver on the golf course;

a memory storing advertising information associated with advertising locations on the golf course;

a processor for comparing the position of the receiver with the advertising information locations; and

a display for displaying the advertising information to the golfer when the position of the receiver is at an advertising information location.

33. The apparatus of claim 32, said display being operable for displaying a graphic representation of said advertising information.

34. The apparatus of claim 33, said display including a digitizer overlaying said graphic representation and a pen operable for providing inputs to said display.

35. The apparatus of claim 32, said display being operable for displaying a graphic representation of a golf hole to the golfer.

36. The apparatus of claim 32, said memory operable for storing different advertising messages and said processor operable for displaying different advertising information at different positions of the receiver on the golf course.

38. The apparatus of claim 32, said display being connected to the global positioning receiver for displaying the advertising information based on movement of the receiver on the golf course.

39. The apparatus of claim 32, said display being operable for displaying advertising information based on an activity of the golfer.

41. A method for displaying advertising information to a golfer on a golf course using a global positioning satellite system comprising the steps of:

positioning a remote global positioning satellite receiver on the golf course;

determining a present position of the remote receiver on the golf course using the global positioning satellite system;

correcting said present position of the remote receiver;

storing one or more advertising information associated with one or more locations on the golf course in a memory of the remote receiver;

comparing the one or more advertising information locations with a position of the remote receiver; and

displaying the associated advertising information to the golfer if a position of the remote receiver is an advertising information location.

IX. EVIDENCE APPENDIX

Declarations of Huston and Herbert under 37 CFR § 1.132 were filed February 20, 2007. Declarations of Huston under 37 CFR § 1.131 were filed February 22, 2005. Copies of the declarations are attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Prior appeals may have a bearing on the Board's decision in this appeal. The present application is a continuation of Serial Number which 08/925,293 which was decided by this Board in Appeal No. 2000-0947. Appeal No. 2000-0947 was appealed to the Court of Appeals for the Federal Circuit 02-1048 decided October 17, 2002. Additionally, Serial Number 09/454,813 was decided by the Board January 24, 2006 in Appeal No. 2005-2769. Copies of the decisions are attached hereto.